

Application No. 09/398,229
Amendment dated May 29, 2007
Response to Office Action of August 24, 2006

Atty. Docket No. 74451.P100
Examiner Boutah, Alina A.
TC/A.U. 2143

Remarks

Applicants respectfully request reconsideration of the present U.S. Patent application as amended herein. No claims have been amended, added or canceled herein. Claim 2 was previously canceled. Thus, claims 1 and 3-45 are pending.

CLAIM REJECTIONS – 35 U.S.C. § 112, FIRST PARAGRAPH

Claims 1, 14, 22 and 28 were rejected as failing to comply with the enablement requirement. The specification as originally filed discloses “a filter to filter the documents so that *only selected documents are published...*” See page 7, lines 6-8 (emphasis added). The specification further states that “the filter comprises a computer that stores and sends an electronic document to a server to ‘publish’ the documents.” See page 7, lines 10-11. Various details related to the function of the filter are provided in other sections of the specification. See, for example, pages 9-10. One of ordinary skill in the art at the time the application was filed would have been able to program a computer to select electronic documents based on the criteria set forth in the specification. Therefore, Applicants submit that application and claims comply with 35 U.S.C. § 112, First Paragraph.

CLAIM REJECTIONS - 35 U.S.C. § 103(a)

Claims 1, 4, 14, 17, 22 and 28-45 were rejected as being unpatentable over U.S. Patent No. 5,848,413 issued to Wolff, et al. (*Wolff*) in view of U.S. Patent No. 5,692,048 issued to Gormish, et al. (*Gormish*) and further in view of U.S. Patent No. 6,584,508

Application No. 09/398,229
Amendment dated May 29, 2007
Response to Office Action of August 24, 2006

Atty. Docket No. 74451.P100
Examiner Boutah, Alina A.
TC/A.U. 2143

issued to Epstein, et al. (*Epstein*) and further in view of U.S. Patent No. 6,742,116 issued to Matsui (*Matsui*).

Claim 1 recites:

a server coupled to the filter and to the multifunction machine, the server having memory to store the multiple electronic documents, the server to select and to publish a subset of electronic documents by selectively transmitting a document identifier and authorization information to one or more recipients, the document identifier and the authorization information to enable the one or more recipients to access one or more of the subset of electronic documents, and further wherein the server, automatically and in association with publication, causes the document identifier to be transmitted to one or more World Wide Web indexing services.

Thus, Applicants claim selecting a publishing a subset of electronic documents by selectively transmitting a document identifier and authorization information to one or more recipients and automatically, in association with publication, causing the document identifier to be transmitted to one or more World Wide Web indexing services. Claims 14, 17, 22 and 28 recite similar limitations.

The section of *Wolff* cited in the Office Action discloses a gateway that receives a fax document and transforms the fax document to a hypertext document. See col. 7, lines 29-30 and 40-49. The documents are stored and identifiers are provided. See col. 7, lines 58-60. However, *Wolff* does not teach or suggest automatically, in association with publication, causing the document identifier to be transmitted to one or more World Wide Web indexing services.

Gormish is cited to teach a fax machine that stores a certain number of faxes in order to have archived documents to search. See page 3 of the Office Action. Whether or not this is an accurate characterization of *Gormish*, nothing in *Gormish* appears to

Application No. 09/398,229
Amendment dated May 29, 2007
Response to Office Action of August 24, 2006

Atty. Docket No. 74451.P100
Examiner Boutah, Alina A.
TC/A.U. 2143

teach or suggest automatically, in association with publication, causing the document identifier to be transmitted to one or more World Wide Web indexing services.

Epstein is cited to teach content-based filtering. However, *Epstein* is not cited to teach, nor does *Epstein* teach, automatically, in association with publication, causing the document identifier to be transmitted to one or more World Wide Web indexing services. *Matsui* is directed to a security strategies for electronic "conversations," but not automatically, in association with publication, causing the document identifier to be transmitted to one or more World Wide Web indexing services. Therefore, nothing in the combination of *Wolff*, *Gormish*, *Epstien* and *Matsui* can teach or suggest the invention as claimed in claims 1, 14, 17, 22 and 28. That is, the combination of *Wolff*, *Gormish*, *Epstien* and *Matsui* does not teach or suggest automatically, in association with publication, causing the document identifier to be transmitted to one or more World Wide Web indexing services.

Claims 4, 29, 30, 37 and 38 depend from claim 1. Claims 31 and 32 depend from claim 14. Claims 33, 34 and 40-42 depend from claim 17. Claims 35, 36 and 43-45 depend from claim 28. Because dependent claims include the limitations of the claims from which they depend, Applicants submit that claims 4 and 29-45 are not rendered obvious by the combination of *Wolff*, *Gormish*, *Epstien* and *Matsui* for at least the reasons set forth above.

Claims 8-13, 15, 16, 18, 23 and 27 were rejected as being unpatentable over *Wolff* in view of *Gormish*, *Epstein* and *Matsui* and further in view of U.S. Patent No. 6,188,673 issued to Bauer, et al. (*Bauer*). *Bauer* is cited to teach the capability to determine and

Application No. 09/398,229
Amendment dated May 29, 2007
Response to Office Action of August 24, 2006

Atty. Docket No. 74451.P100
Examiner Boutah, Alina A.
TC/A.U. 2143

communicate page hits and logging. See Office Action at page 6. However, *Bauer* is not cited to cure, nor does *Bauer* cure, the deficiencies of the combination of *Wolff*, *Gormish*, *Epstein* and *Matsui* set forth above. Therefore, no combination of *Wolff*, *Gormish*, *Epstein*, *Matsui* and *Bauer* can teach or suggest the invention as claimed in claims 8-13, 15, 16, 18, 23 and 27.

In rejecting claim 13, the Office Action takes Official Notice that performing virus removal is "notoriously well known in the art." See Office Action at page 7. However, the Office Action provides no evidence to support the assertion that virus removal was well known in the art *at the time of the filing* of the application. Therefore, in accordance with MPEP §2144.03, Applicant hereby traverses Examiner's Official Notice and respectfully requests that the Examiner either (1) cite a prior art reference that supports such a position pursuant to MPEP § 706.02(a); (2) submit an affidavit pursuant to C.F.R. 1.104(d)(2); or (3) withdraw the obviousness assertion.

Claims 5-7, 19-21 and 24-26 were rejected as being unpatentable over *Wolff*, *Gormish*, *Epstein* and *Matsui* and further in view of U.S. Patent No. 6,317,777 issued to Skarbo, et al. (*Skarbo*). *Skarbo* is cited to teach deleting a document or preventing access to the document upon certain conditions. See Office Action at page 9. However, *Skarbo* is not cited to cure, nor does *Skarbo* cure, the deficiencies of the combination of *Wolff*, *Gormish*, *Epstein* and *Matsui* set forth above. Therefore, no combination of *Wolff*, *Gormish*, *Epstein*, *Matsui* and *Skarbo* can teach or suggest the invention as claimed in claims 5-7, 19-21 and 24-26.

Application No. 09/398,229
Amendment dated May 29, 2007
Response to Office Action of August 24, 2006

Atty. Docket No. 74451.P100
Examiner Boutah, Alina A.
TC/A.U. 2143

Conclusion

For at least the foregoing reasons, Applicants submit that the rejections have been overcome. Therefore, claims 1 and 3-45 are in condition for allowance and such action is earnestly solicited. The Examiner is respectfully requested to contact the undersigned by telephone if such contact would further the examination of the present application.

Please charge any shortages and credit any overcharges to our Deposit Account number 02-2666.

Respectfully submitted,
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN, LLP

Date: May 29, 2007

/Paul A. Mendonsa/
Paul A. Mendonsa
Reg. No. 42,879

12400 Wilshire Boulevard
Seventh Floor
Los Angeles, CA 90025-1026
(503) 439-8778